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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,752	10/31/2001	Richard H. Harris	RPS920010068US1	3546
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SAWYER LAW GROUP P.O. Box 51418 Palo Alto, CA 94303			EXAMINER AU, SCOTT D	
			ART UNIT 2635	PAPER NUMBER

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,752

Applicant(s)

HARRIS, RICHARD H.

Examiner

Scott Au

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This communication is in response to applicant's response to an Amendment, which is filed September 13, 2004.

An amendment to the claims 9-16 have been entered and made of record in the Application of Harris for a "Secure smart card" filed October 31, 2001.

Claims 1-8 are canceled.

Claims 17-22 are added.

Claims 9-22 are pending.

Response to Arguments

Applicant's arguments with respect to claims 9-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kapp et al. (US# 5,949,348) in view of Suzuki (US# 4,742,351).

Referring to 9, Kapp et al. disclose a transaction device (20), comprising:
an inputting means (49) (i.e. keyboard representation) for receiving an inputted identification data (col. 2 lines 5-9 and col. 5 lines 8-12; see Figure 1);
a decoder (20) (i.e. writing input device) coupled to the inputting means (49) (i.e. keyboard representation) for sensing, decoding and verifying the inputted identification data (col. 2 lines 10-20 and col. 3 lines 5-23; see Figure 3); and a processor (64) (i.e. personal computer) coupled to the decoder (20) (i.e. writing input device), wherein the decoder asserted an activation signal to the processor if the identification verification data is verified, wherein the decoder de-asserts the activation signal when event occurs and presentation to be loaded in presentation for the next customer (col. 7 lines 39-53).

However, Kapp et al. did not explicit disclose wherein the inputted identification verification data is not shared with another device.

In the same field of endeavor of transaction system, Suzuki discloses the inputted identification verification data is not shared with another device (col. 4 lines 1-32). The inputted identification data is from card (11) and when is inserted in the transaction device 12 where only the PAN or PAN' (i.e. primary account number) of the card is sent to transaction device 12 and being compared to identify if the card is valid.

One ordinary skill in the art understands that PAN or PAN' of Suzuki is desirable in the transaction system of Kapp et al. because Kapp et al. suggest verifying the identity of the user of the business terminal by comparison of the personal identification data through key interface (24) or using card through slot (34) with the signature data contained in the system (col. 3 lines 5-10 and col. 4 lines 30-45) and Suzuki suggests

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the inputted identification data is from card (11) and when is inserted in the transaction device 12 where only the PAN or PAN' (i.e. primary account number) of the card is sent to transaction device 12 and being compared to identify if the card is valid (col. 4 lines 1-32).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time of the invention was made to include the inputted identification verification data is not shared with another device of Suzuki in the transaction device of Kapp et al. with the motivation for doing so would allow using card input as an alternative of using key input to transaction device for authorization.

Referring to claim 10, Kapp et al. in view of Suzuki disclose the device of claim 9, Kapp et al. disclose wherein the event comprises a completion of a secure transaction (col. 2 lines 1-13).

Referring to claim 14, Kapp et al. in view of Suzuki disclose the device of claim 9, Suzuki discloses wherein the decoder (i.e. circuitry of device 12) comprises a stored identification verification data by determining that the inputted identification verification data (PAN or PAN') matches the stored identification data (col. 4 lines 1-32).

Referring to claim 17, Kapp et al. disclose a method for providing a secure transaction, comprising the steps of:

a) receiving an inputted identification verification data by a transaction device directly from a user (col. 2 lines 5-9 and col. 5 lines 8-12; see Figure 1);

b) sensing, decoding, and verifying the inputted identification verification data by decoder of the transaction device (col. 2 lines 10-20 and col. 3 lines 5-23; see Figure 3);

c) asserting an activation signal to a processor coupled to the decoder (20) (i.e. writing input device) if the identification verification data is verified, wherein the decoder de-asserts the activation signal when an event occurs (col. 7 lines 39-53).

However, Kapp et al. did not explicit disclose wherein the inputted identification verification data is not shared with another device.

In the same field of endeavor of transaction system, Suzuki discloses the inputted identification verification data is not shared with another device (col. 4 lines 1-32). The inputted identification data is from card (11) and when is inserted in the device 12 where only the PAN or PAN' (i.e. primary account number) of the card is sent to device 12 and being compared to identify if the card is valid.

See claim 9 above for similar motivation.

Claims 11 and 19-22 are rejected under 35 U.S.C 103(a) as being unpatentable over Kapp et al. (US# 5,949,348) in view of Suzuki (US# 4,742,351) as applied to claim 9 above and further in view of Grant et al. (US# 6,095,416).

Referring to claim 11, Kapp et al. in view of Suzuki disclose the device of claim 9, Kapp et al. disclose wherein the decoder (20) (i.e. writing input device) de-asserts the

activation signal to the processor (64) (i.e. personal computer) once a transaction is completed and representation to be loaded in preparation for the next customer (col. 7 lines 39-53). However, Kapp et al. in view of Suzuki did not explicitly disclose wherein the timer circuit is initiated when the decoder asserts the activation signals, wherein the timer circuit expires after a predetermined period of time, wherein the event comprise the expiration circuit, wherein the decoder de-asserts the activation signal to the processor when the timer circuit expires.

In the same field of endeavor of authorization of transaction, Grant et al. disclose wherein the timer circuit (col. 4 line 57) is initiated when the decoder (col. 8 lines 54-55) asserts the activation signals, wherein the timer circuit (col. 4 line 57) expires after a predetermined period of time, wherein the event comprise the expiration circuit, wherein the decoder (col. 8 lines 54-55) de-asserts the activation signal to the processor when the timer circuit expires (col. 3 lines 59-62) to prevent fraudulent transaction.

One of ordinary skill in the art understands that the security method of activating signals for a predetermined time of Grant et al. is desirable in transaction device of Kapp et al. in view of Suzuki because both Kapp et al. and Suzuki disclose a financial transaction system with identification input is being compared and verified for authorization (i.e. Kapp et al., see col. 1 lines 14-23) and (i.e. Suzuki, see col. 1 line 59 to col. 2 line 7) and Grant et al. suggest a timer is used in an Automated Teller Machine to activate for a predetermined of time once the correct PIN is entered (col. 1 lines 13-22 and col. 3 lines 58-62). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to include the timer of

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Grant et al. in the transaction device of Kapp et al. in view of Suzuki with the motivation for doing so would prevent a fraud transaction is attempted one time is expired.

Referring to claim 19, Kapp et al. in view of Suzuki disclose the method of claim 17, Kapp et al. disclose (c1) determining if the inputted identification verification data matches a new identification data stored at the transaction device; (c2) asserting the activation signal if the inputted identification verification data matches the new identification verification data (col. 7 lines 39-53).

However, Kapp et al. in view of Cecil et al. did not explicitly disclose (c3) starting a timer if the activation signal is asserted, wherein the timer expires after the predetermined period of time.

In the same field of endeavor of authorization of transaction, Grant et al. disclose starting a timer if the activation signal is asserted, wherein the timer expires after the predetermined period of time (col. 3 lines 59-62).

See claim 11 above for similar motivation.

Referring to claim 20, Kapp et al. in view of Suzuki and Grant et al. disclose the method of claim 19, Grant et al. disclose (c4) de-asserting the activation signal when the timer expires (col. 3 lines 59, 62).

Referring to claim 21, Kapp et al. in view of Suzuki and Grant et al. disclose the method of claim 19, Kapp et al. disclose (c5) de-asserting the activation signal when the secure transaction is completed (col. 7 lines 39-53).

Referring to claim 22, Kapp et al. in view of Suzuki and Grant et al. disclose the method of claim 19, Kapp et al. disclose wherein the new identification verification data comprises a signature (col. 3 lines 5-8).

Claims 12-13 are rejected under 35 U.S.C 103(a) as being unpatentable over Kapp et al. (US# 5,949,348) in view of Suzuki (US# 4,742,351) as applied to claim 9 above and further in view of Mears (US# 5,539,400).

Referring to claim 12, Kapp et al. in view of Suzuki disclose the device of claim 9. However, Kapp et al. in view of Suzuki did not explicitly disclose wherein the inputting means comprises a plurality of capacitive keys, where each capacitive key comprises a first side and a second side.

In the same field of endeavor of keypad device, Mears discloses wherein the inputting means comprises a plurality of capacitive keys, wherein each capacitive key comprises a first side and a second side (col. 3 lines 17-29; see Figures 2 and 4) where is coupled to oscillator on one side and coupled to the decoder (90) (i.e. encoder function as decoder) on the second side.

One ordinary skill in the art understands that capacitive keys of Mears are desirable in the transaction device of Kapp et al. in view of Suzuki because both Kapp et al. and Suzuki disclose a financial transaction system with identification input is being compared and verified for authorization (i.e. Kapp et al., see col. 1 lines 14-23) and (i.e. Suzuki, see col. 1 line 59 to col. 2 line 7) and Mears suggests capacitive keys are used in an automated teller machine system (col. 1 lines 31-39). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to include the capacitive keys of Mears in the transaction system of Kapp et al. in view of Suzuki with the motivation for doing so would allow the user to input the identification data through the ATM to gain access to their account.

Referring to claim 13, Kapp et al. in view of Suzuki disclose the device of claim 9, Mears discloses further comprising: an oscillator (70) (i.e. an oscillator) coupled to the inputting means (52) (i.e. keypad array); and a power source (62) (i.e. battery) coupled to the oscillator (70) (i.e. an oscillator) and the decoder (90) (i.e. an encoder functions as decoder) (col. 3 lines 17-29 and col. 4 lines 9-19; see Figure 1-2 and 4).

Claims 15-16 are rejected under 35 U.S.C 103(a) as being unpatentable over Kapp et al. (US# 5,949,348) in view of Suzuki (US# 4,742,351), Grant et al. (US# 6,095,416) and further in view of Mears (US# 5,539,400).

Referring to claim 15, Kapp et al. in view of Suzuki, Grant et al. and Mears disclose the device, claim 15 equivalent to that the combine of claims 9, 11-13 addressed above, incorporated herein. Therefore, claim 15 is rejected for the same reasons given with respect to claims 9, 11-13 combined and to the extent that Kapp et al. suggest decoder (20) (i.e. writing input device) coupled to second side of key (49) for sensing, decoding, and verifying the inputted identification data (col. 2 lines 10-20 and col. 3 lines 5-23; see Figure 3).

Referring to claim 16, Kapp et al. in view of Suzuki, Grant et al. and Mears disclose the device, claim 16 equivalent to that the combine of claims 9, 12-13 addressed above, incorporated herein. Therefore, claim 16 is rejected for the same reasons given with respect to claims 9, 12-13 combined and to the extent that Kapp et al. suggest decoder (20) (i.e. writing input device) coupled to second side of key (49) for sensing, decoding, and verifying the inputted identification data (col. 2 lines 10-20 and col. 3 lines 5-23; see Figure 3).

Claim 18 is rejected under 35 U.S.C 103(a) as being unpatentable over Kapp et al. (US# 5,949,348) in view of Suzuki (US# 4,742,351) as applied to claim 17 above and further in view of Lessin et al. (US# 4,868,376).

Referring to claim 18, Kapp et al. in view of Suzuki disclose the method of claim 17. It is obvious that Kapp et al. disclose the initial identification data being stored in the

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system so when the user enter the new identification data which being compared with the initial identification data in order to authorized the transaction. However, in the same field of endeavor of transaction system, Lessin et al. disclose wherein the receiving step (a) comprises:

- (a1) assigning an initial identification verification data to the user (i.e. current PIN of the user);
- (a2) receiving the initial identification verification data by the transaction device directly from the user (i.e. step 860);
- (a3) verifying the initial identification verification data by the transaction device (i.e. step 862);
- (a4). receiving an indication of a new identification verification data by the transaction device (i.e. step 872); and
- (a5) receiving the new identification verification data by the transaction device directly from the user (i.e. step 878) (col. 13 lines 20-48; see Figure 15C).

One ordinary skill in the art understands that initializing identification data and comparing the initializing identification data with the entered identification data of Lessin et al. is desirable in the transaction system of Kapp et al. in view of Suzuki because both Kapp et al. and Cecil et al. disclose a financial transaction system with identification input is being compared and verified for authorization (i.e. Kapp et al., see col. 1 lines 14-23) and (i.e. Suzuki, see col. 1 line 59 to col. 2 line 7) and Lessin et al. also suggest the method can be applied to ATM system (col. 1 lines 15-17) in order to authorize the user with a valid transaction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Au whose telephone number is (571) 272-3063.

The examiner can normally be reached on Mon-Fri, 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached at (571) 272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-3906.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Scott Au

MICHAEL HORABIK
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